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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/334,185

06/16/1999

FRANK LIEBENOW

GW98-0769/34

5042

30408

7590

08/13/2002

GATEWAY, INC.
ATTENTION: IP LAW GROUP (MAIL STOP SD-21)
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EXAMINER

BUI, KIEU OANH T

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 08/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/334,185

Applicant(s)

LIEBENOW, FRANK

Examiner

KIEU-OANH T BUI

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless --
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.*

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Matthews, III et al. (U.S. Patent No. 6,025,837).

Regarding claim 1, Matthews, III et al (or "Matt" hereinafter) disclose a method comprising the actions of: "maintaining a subset of program information for at least one related program of a given program with program information for the given program, and performing at least one program event for the given program and, based upon the subset of program information, the at least one related program", i.e, Matt clearly discloses a system and a method for broadcasting programs with its program information itself to users as well as the program information of a related program of that program to users/viewers, for instance, as the user picks or chooses "Seinfeld" program (Fig. 5/item 126), a descriptive window box 128 shows the program information of the program "Seinfeld" itself, as well as the related program information, as the user chooses MORE for more supplemental information, "Last week" for the last episode of the current playing program (emphasis added), and "Comedy Club" (140) as another related

program information of “Seinfeld” (Fig. 5, and col. 9/lines 34 to col. 10/line 13), (which it exactly reads on the claim language of the present application).

As for claim 2, in further view of claim 1 above, Matt further discloses “the action of maintaining the program information for the given program, including the subset of program information for the at least one related program, in an electronic program guide (EPG)”, i.e, an EPG that displays program schedule information in accordance with one of a plurality of user selectable modes as well as storage means for maintaining the program information (Fig. 5 as illustration for an EPG, and Fig. 4/item 96 for a program memory for maintaining the program information EPG in section 104).

With respect to claim 3, the steps of “providing information associated with the subset of program information for the at least one related program to a user; obtaining user input based on the information provided; and performing program events based on the user input” are revealed by Matt as Matt clearly shows that the user can access the “Seinfeld” program with program information on 120 and MORE information as one clicks on 140, and other related programs with their subset of program information are provided and displayed on the television screen as the user clicks on “Last week” or “Comedy Club” at item 140 (Fig. 5, and col. 9/line 55 to col. 10/line 14).

Regarding claim 4, Matt further clearly discloses “wherein the action of performing program events includes recording the given program and the at least one related program” by scheduling a recording session for a particular related program, if desired (Fig. 8/step 216 and col. 12/lines 18-29).

As for claim 5, Matt discloses “wherein the subset of program information is appended to the program information for the given program”, i.e, as the user clicks on the program information of the given program, the subset of program information is displaying (col. 9/line 34 to col. 10/line 20).

Regarding claim 6, Matt discloses a system comprising:

at least one processor (Fig. 4/item 92);

memory operably associated with said processor, i.e., either a volatile memory is of concern (Fig. 4/item 92) or a program memory (Fig. 4/item 96); and

a program of instructions configured to be executed by said processor and stored in said memory, said program of instructions including instructions configured to maintain a subset of program information for at least one related program of a given program with program information for the given program, and perform at least one program event for the given program and, based upon the subset of program information, the at least one related program, i.e., an operating software program is used to control and configure instructions or commands in order to maintain and update the program schedule information including a subset of program information for at least one related program and to perform the program event for any given program as preferred (Fig. 4/items 101, 104, and col. 8/lines 20-67 with a subset of program information as explained earlier in claim 1).

As for claim 7, Matt shows “wherein said program of instructions further includes instructions configured to maintain the program information for the given program, including the subset of program information for the at least one related program, in an electronic program guide (EPG)”, i.e., an EPG that displays program schedule information in accordance with one of a plurality of user selectable modes as well as storage means for maintaining the program information with program of instructions” (see Fig. 4, and col. 8/lines 20-67 as discussed in claim 6 above).

With respect to claim 8, Matt further reveals “wherein said program of instructions further includes instructions configured to provide information associated with the subset of program information for the at least one related program to a user; instructions configured to obtain user input based on the information provided; and instructions configured to perform

program events based on the user input” are revealed by Matt as Matt clearly shows that the user can access the “Seinfeld” program with program information on 120 and MORE information as one clicks on 140, and other related programs with their subset of program information are provided and displayed on the television screen as the user clicks on “Last week” or “Comedy Club” at item 140 (Fig. 5, and col. 9/line 55 to col. 10/line 14 with program of instructions as discussed in claim 6 above).

As for claim 9, Matt further discloses to include “a recording device”, i.e., recording scheduling programs (as shown in Fig. 8/item 216, and col. 9/lines 45-55 for a recording device).

With respect to claim 10, the step of “wherein the subset of program information is appended to the program information for the given program”, i.e, as the user clicks on the program information of the given program, the subset of program information is displaying (col. 9/line 34 to col. 10/line 20).

Regarding claims 11-19, these claims for “a computer readable medium tangibly embodying a program of instructions implementing the method above” and “a signal tangibly embodied in a propagation medium comprising at least one instruction configured to maintain; in an electronic program guide (EPG), a subset of program information for at least one related program of a given program with program information for the given program; and at least one instruction configured to perform at least one program event for the given program and, based upon the subset of program information, the at least one related program” are rejected for the reasons given in the scope of method and system claims 1-10 as already discussed in details above.

Response to Arguments

3. Applicant's arguments filed on 06/04/2002 have been fully considered but they are not persuasive.

The Applicant basically argues that Matthews fails to disclose or teach independent claims 1, 6, 11 and 16 recite the limitation of "a subset of program information for at least one related program of a given program with program information for the given program" by providing explanation or defining "a related program" with more descriptions and an example in the specifications (emphasis added) (pages 2, lines 7-13; and page 12, line 16 to page 13, line 15). However, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., episodes of recurring programs, segments of a multi-part program, programs with similar content, and programs related through an intermediate program ...) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, the Examiner stands with the disclosure of Matthews as discussed in the previous Office Action and disagrees with the Applicant's arguments based on the disclosed reason in this Final Office Action.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krista Kieu-Oanh Bui whose telephone number is (703) 305-0095. The examiner can normally be reached on Monday-Friday from 9:00 AM to 6:00 PM, with alternate Fridays off.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile, can be reached on (703) 305-4380.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Krista Bui
Art Unit 2611
August 01, 2002


ANDREW FAILE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600